

## REMARKS

### Amendments

Support for new claim 18 can be found throughout the specification.

### The Rejections under 35 U.S.C. §112, second paragraph

The rejections of claims 10, 11 and 12 under 35 U.S.C. §112, second paragraph, are respectfully traversed.

The terms "ortho-nasal" (i.e., through the mouth) and "retro-nasal" (i.e., through the nose) are defined on page 4, lines 14-15 of the specification. These terms are fully conventional and would be known by one skilled in the art. Their meaning can be further defined by the context in which they are used on page 4, lines 8-15.

Thus, the rejections under 35 U.S.C. §112, should be withdrawn.

### The Delmore et al (EP 1,033,118) Rejection under 35 U.S.C. §102 and §103

The rejections under 35 U.S.C. §102 and §103 are respectfully traversed.

The *Background of the Invention* section of Delmore discloses that nasal dilators may be used for increased athletic performance, as the examiner notes (See col. 1, lines 19-21). But this relates only to the well-touted mechanical effects of such dilators. Manufacturers of the nasal dilators strongly promote them for use in increasing athletic performance. They claim that the opening of the nostrils allows a greater amount of air to pass through to the lungs. Thus, the snoring allegation claim also in parallel to the performance claim in col. 1. Regardless of the effectiveness of nasal dilators in athletic performance, the mechanical methods of enhancement of athletic performance by physically opening the nostrils to increase the amount air in the lungs is not the same as enhancing athletic performance by administering an olfactory stimulating amount of peppermint odorant.

The devices of Delmore also are referred to as medical nasal dilators. This is an entirely different use. Col. 7 lines 9-45 lists the possible medications that may be incorporated into the microcapsules for such purposes. Peppermint oil is listed as just one of many possible medications. But, enhancement of athletic performance is not a medical use. There is no mention or hint in Delmore of whether peppermint oil or anything else should be or can be used in athletic performance. Nothing in Delmore would lead one to select peppermint oil from the list of possible medicants for use in a method of enhancing athletic

performance.

The Delmore reference provides no specific embodiment or specific evidence to suggest a method of enhancing athletic performance meeting the recitations of claim 1. A mere broad generic disclosure without any specific direction as to the specific element necessary to provide an anticipation is not an anticipatory disclosure. In other words, such a broad generic disclosure does not "describe" an embodiment therein in accordance with 35 U.S.C. §102. See *In re Kollman et al*, 201 USPQ 193 (CCPA 1979)

In the absence of any specific direction in the reference to a method meeting Applicants' claims, the reference cannot be anticipatory. As can be seen, the reference also does not suggest achieving athletic performance enhancement using peppermint odorant. The latter is mentioned only in the context of "medication" in no way relating to athletic performance. It does not render the claims obvious.

Thus, the 35 U.S.C. §102 rejection should be withdrawn

#### **The Weil (DE 3931150) Rejection under 35 U.S.C. §102**

The rejection of claims 1-10,12,13,15 and 16 under 35 U.S.C. §102 as being anticipated by Weil (DE 3931150), is respectfully traversed.

DE 3931150 teaches a perfume composition that contains lemon oil and peppermint oil. The composition may further contain basil oil and clove oil. Among other uses, it is stated that the perfume composition is used to overcome mental and bodily fatigue. Such fatigue is not defined. In any event, it is not the same as athletic performance enhancement. Nor is it the same as the subject matter of claims 2-9. Moreover, the examiner has not established that pleasantness of a scent is sufficient to induce enhancement of athletic performance. In any event, this is not true. As can be seen throughout applicant's specification, jasmine, which is perceived as a pleasant odor, did not have any athletic performance enhancing effect in comparison to the control. See for example, figure 3. ] ?

Thus, the 35 U.S.C. §102 rejection should be withdrawn.

#### **The Rejections under 35 U.S.C. §103**

The rejection of claims 2-9 under 35 U.S.C. §103 as being rendered unpatentable by Delmore (EP1033118), is respectfully traversed.

As stated above, for the reasons given, Delmore does not provide any teaching as to using peppermint odorant to enhance athletic performance. Furthermore, there is no suggestion in Delmore to make any modifications to its methods to arrive at the method of the present invention. Delmore relates a medical device.

The rejection of claim 11 under 35 U.S.C. §103 as being unpatentable over Weil (DE 3931150) in view of Xiao (CN 1285154), is respectfully traversed.

The rejection of claims 11 and 15 under 35 U.S.C. §103 as being unpatentable over Delmore (EP1033118) in view of Xiao (CN 1285154), is respectfully traversed.

Xiao relates to a tea made from a mixture of medicinal materials. Peppermint leaf is just one of ten components listed. But nothing correlates this claim to peppermint. The reference attributes many positive effects from drinking the tea including resisting fatigue. Is this effect due to the hydration effects of the tea or one of the ten other herbs listed? The reference provides no mention of enhancing athletic performance by exposure to peppermint-odorant-to-arrive-at-the method of applicant's invention. There is no motivation or suggestion in either Delmore, Weil or Xiao to use peppermint odorant to enhance athletic performance.

The rejection of claim 14 under 35 U.S.C. §103 as being unpatentable over Weil (DE 3931150) in view of Cronk et al (US 5,706,800), is respectfully traversed.

Cronk et al. teaches the use of a medicated menthol nasal dilator for increasing breathing. Menthol, camphor, lavender and/or peppermint oil are listed as possible aromatic medications disposed on the dilator. As stated above for Delmore, use of a mechanical means of increasing breathing (with possible decongestant substances disposed on the surface) is not same as enhancing athletic performance through the use of peppermint odorant. Neither Cronk nor Weil suggest or teach the use of peppermint odorant to enhance athletic performance.

The rejection of claim 17 under 35 U.S.C. §103 as being unpatentable over Weil (DE 3931150) in view of Stephens (The horse scents guide to good health, 2000), is respectfully traversed.

Stephens teaches the application of aromatherapy to both humans and horses in order to alleviate physical and emotional problems. The reference suggests that rubbing peppermint oil down a horse's neck and chest can help it get over trauma, relieve lung

problems, arthritis and lameness and counter emotional and behavioral problems. Alleviating physical and emotional problems implies a pathological state. The present claims relate to something different, enhancement of athletic performance through exposure to peppermint odorant.

Neither the Weil nor the Stephens references provide any hint or guidance that peppermint odorant can be used to increase athletic performance.

Before obviousness may be established, the examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles. Obviousness cannot be established by combining the teachings of prior art in order to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. It is not enough that a person could smell peppermint while by chance performing athletically.

Since none of the prior art references, either alone or in combination, suggests or teaches the use of peppermint odorant to enhance athletic performance the 35 U.S.C. §103 rejections should be withdrawn

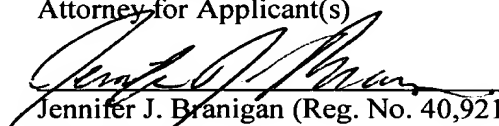
It is submitted that the claims are in condition for allowance.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Should the Examiner have any questions or comments, he is invited to telephone the undersigned at the number below.

Respectfully submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

12. A method according to claim 1, wherein the administration is through the ~~mucus membranes~~ a mucous membrane.